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NIXON PEABODY LLP 161 N CLARK ST. 48TH FLOOR CHICAGO, IL 60601-3213			EXAMINER HYLINSKI, STEVEN J	
			ART UNIT 3714	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/763,638

Applicant(s)

JOSHI ET AL.

Examiner

STEVEN J. HYLINKSI

Art Unit

3714

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/07/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-25 and 27-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-25, 27-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Remarks/Arguments

1. Examiner agrees with Applicant's remarks that claims 1-13, 15-25, and 27-37 are distinguished over the previously-applied rejections under Giobbi. By extension, the rejections under Baerlocher are also overcome, since the max wager of Baerlocher was treated as a side wager, much like the max wager feature of Giobbi previously relied upon. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of US 6,186,894 to Mayeroff.

Claim Objections

2. Claims 27 and 30-37 are objected to because of the following informalities: Claim 27 is drawn to being dependent on cancelled claim 26. Examiner's interpretation is that claim 27 should recite dependence to claim 25. Claim 30 recites dependence on claim 31, which then recites dependence on itself. It also appears that claims 30-32 may depend on claim 29. The examiner can not discern how claims 33-35 can all depend on claim 34, or what claim 34 depends on. Claim 37 depends on objected-to claim 27 and thus also falls under this objection. The rejections of claims 30-37 are based on the examiner's best interpretation of what the dependency of the claims should be. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3714

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 4-7, 12-18, 25, 27-29, and 31-34 are rejected under 35

U.S.C. 102(b) as being anticipated by US 6,186,894 to Mayeroff.

Re Claim 1,

Mayeroff discloses a method for playing a wagering game having a special payout (Abstract), the method comprising: presenting a basic game having a plurality of randomly selected outcomes including a special-payout outcome (Abstract. Also, Table 1 shows some of the possible winning slot reel outcomes. Table 2 shows exemplary bonus game-triggering reel combinations, and Table 3 shows payouts correlating to certain bonus game outcomes) 1); presenting a side-wager option for a player (Col. 4 Lines 54-64 disclose that the machine has separate buttons to wager on one payline, which constitutes a base wager since it is the minimum wager that can be applied to play the game, and also three, five, seven, and nine payline buttons. The three, five, seven, and nine payline wager buttons **62, 63, 64, and 65** all constitute side wagers since they are not required for game play to proceed, they can be discretionarily selected independently by the player, and increasing the number of paylines is known to increase the probability of achieving a winning combination on an active payline.); in response to a player not choosing the side-wager option, providing the player with a first probability greater than zero of achieving the special- payout outcome; in response to the player choosing the side-wager option, providing the player with a second probability of achieving the special-payout outcome, the second probability being

greater than the first probability (Table 2 shows an example of what winning combinations on the reels **21-25** will trigger a bonus game. Col. 1 Lines 20-28 and Col. 44 Lines 54-64 disclose the discretionary selection of more than one payline. It is inherent that selecting more paylines in a slot game, with a fixed payable, will increase the probability of one of the predetermined winning combinations, including the bonus-game-triggering combinations of Table 2, occurring); conducting the basic game with the first probability or the second probability, depending on the player's choice on the side-wager option (Col. 5 Lines 65-67, the player selects how many paylines, ie. how many side wagers since at least one payline must be played, to play. Col. 6 Lines 5-13, following additional wager parameter selection, the game is conducted based on the player's parameters) ; and in response to conducting, crediting the player the special payout when the special-payout outcome occurs in the basic game (Table 3 shows special payouts that can occur during the bonus game).

Re Claim 2,

Mayeroff discloses more than two other payouts that occur when corresponding randomly selected outcomes occur on the reels (See the representative payable of Col. 6 Lines 20-45)

Re Claims 4 and 31,

Mayeroff discloses a method and gaming terminal wherein the special payout is a bonus game (See Col. 7 Lines 5-25. The bonus game consists of the player being allowed to spin a special bonus reel **40**. This bonus game is triggered from such exemplary reel combinations as those shown in Table 2.).

Re Claims 5, 7, 18, 32, and 34,

Mayeroff discloses a method and gaming terminal wherein the plurality of randomly selected outcomes are indicated by a slot machine and each of the plurality of symbols is a reel symbol (see Fig. 2 and Table 1).

Re Claims 6, 16-17, and 33,

Mayeroff discloses in Col. 6 Lines 47-54 that any symbols representing a common theme could be used on the reels.

Re Claims 12, 15, and 25

Mayeroff discloses a gaming terminal for playing a wagering game having a special payout with a first payout and a second payout (Table 2 shows exemplary reel combinations that can trigger a bonus round, and Table 3 shows different payouts, including at least first and second special payouts, that can be obtained during the bonus round.), the gaming terminal comprising a basic game having a randomly selected outcome (Fig. 2, the base game is a slot machine), the gaming terminal having two options for being eligible for the special payout, the two options including (i) a side-wager input option (Col. 4 Lines 54-64 disclose that the machine has separate buttons to wager on one payline, which constitutes a base wager since it is the minimum wager that can be applied to play the game, and also three, five, seven, and nine payline buttons. The three, five, seven, and nine payline wager buttons **62**, **63**, **64**, and **65** all constitute side wagers since they are not required for game play to proceed, they can be discretionarily selected independently by the player, and increasing the number of paylines is known to increase the probability of achieving a winning combination on an

Art Unit: 3714

active payline.) and (ii) a max-wager option (Col. 2 Lines 46-53 disclose the presence of a maximum wager that the player can apply. Also, Col. 4 Lines 54-64 disclose an exemplary payline scheme with a total of nine possible paylines. The dedicated nine-payline wager button **65** is a "max wager" button.), whereby, in response to selection of one of the two options, the gaming terminal awards the player the first payout when a first randomly selected outcome is achieved in the basic game and the gaming terminal awards the player the second payout when a second randomly selected outcome is achieved in the basic game (Col. 6 Lines 55-60).

Re Claim 13,

Mayeroff discloses a gaming terminal wherein the special payout is one of a progressive jackpot and a bonus game jackpot (Table 3 shows the bonus game jackpot payout can be up to 100 credits).

Re Claims 27 and 37,

See Table 1 of Mayeroff, which shows a paytable with different winning combinations.

Re Claims 28-29,

See the rejections of claims 1 and 12 above. Col. 6 Lines 13-14 disclose that the player's wins are evaluated on the active paylines. The player can choose as few as one payline (Col. 5 Lines 65-67). When no paylines beyond the one minimum payline (Col. 1) have been selected, the player still has an opportunity to achieve the bonus round, according to the bonus round triggering combinations of Table 2, and the bonus

Art Unit: 3714

payout table 3. Col. 8 lines 13-15 further disclose that once the player reaches the bonus round, there is a guaranteed minimum payout (in this exemplary case, 8 credits).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 23, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayeroff as discussed above, further in view of US 7,029,395 to Baerlocher.

Re Claims 3, 23, and 30,

Mayeroff discloses the same inventive concept, substantially as claimed, with the exception of the special bonus payoff being a progressive prize.

The use of progressive prizes for special awards, such as disclosed by Baerlocher in 9:61-67 and 10:1-15, is old and notoriously well-known in the art of casino gaming.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have incorporated Baerlocher's teaching of a special prize in a casino slot machine being a progressive jackpot prize, into the analogous slot machine of Mayeroff, with predictable results. Also, it is well-known in the art that the potential for winning a very large jackpot, with a small wager, makes progressive gaming attractive to many players.

7. Claims 8 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayeroff, further in view of US 2004/0166918 to Walker.

Re Claims 8, and 35-36,

Mayeroff discloses the same inventive concept, substantially as claimed, with the exception of the odds of hitting a predetermined jackpot pattern on the reels are varied.

Walker discloses a method and apparatus for changing the parameters of a casino slot machine during game play (Abstract). Walker teaches providing changing the probability of achieving a payout outcome comprising changing the number of winning symbols in the plurality of symbols (Walker Paragraph 24 defines the term "game play parameter" as including the number of symbols on a specific reel, and the probability of the character appearing on a given handle pull". In Paragraphs 103-104, Walker discloses that the gaming device 104 or the casino can vary the game play parameters during play, to control the number of bonus symbols on each reel which initiate a bonus round).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have incorporated Walker's well-known teaching of the gaming machine varying the number of winning symbols on the reels during game play, into the analogous slot machine of Mayeroff, with predictable results.

8. Claims 10-11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mayeroff, further in view of Baerlocher, as discussed above in claim 3, and Walker, as discussed above in claims 8, 11, and 35.

Art Unit: 3714

Re Claims 10-11,

See the rejection of claims 1, and 3 above. Additionally, Walker Paragraphs 24, 103, and 104, as discussed in the rejection above, teach modifying a reel during the course of game play, by changing the number of bonus triggering symbols on it. Therefore a second reel is a first reel that has had the symbols modified.

9. Claims 19-22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayeroff, further in view of US 2003/0064807 to Walker.

Re Claim 19,

See the rejection of claim 12 above for a discussion of two options being available for the special payout. Mayeroff further discloses gaming terminals further comprising signage located above and coupled to the gaming terminals (Fig. 1 **40**, a set top box containing bonus reels), the signage displaying the special payout and for receiving a signal from one of the gaming terminals that the gaming terminal is eligible to win a special payout (the bonus display **40** can receive a signal from the gaming machine **10** that the player has achieved one of the bonus triggering combinations shown in Table 2.

However, Mayeroff lacks the gaming machine **10** being in combination with at least one other gaming terminal for conducting wagering games, the gaming terminals and the signage being a gaming system.

Walker discloses an analogous system comprising networked casino gaming devices for playing games of chance including slot games and card games (Abstract and Paragraph 42). Walker teaches the plurality of casino gaming machines (Fig. 1A,

Art Unit: 3714

gaming devices **104, 106, 108**) being in combination with at least one other gaming terminal (Fig. 1A, the gaming devices are networked) for conducting wagering games (Paragraph 42), the gaming terminals and the signage being a gaming system (each of the gaming devices (Fig. 1A and Paragraphs 30-32, a system for linked game play wherein players can compete as a group or against each other, and Paragraph 50, wherein each of the gaming devices has one or more video output devices).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have incorporated Walker's teaching of a single gaming machine being used in a network in order to interact with other gaming machines, into the disclosure of Mayeroff, because networked game play is old and well-known in the art, and also because many gamblers enjoy the social interaction that linked gaming provides (Walker, Paragraph 16).

Re Claims 20-21,

Mayeroff in view of Walker further teaches a gaming system wherein the signage includes a signage controller for controlling an outcome of the special payout on one of the gaming terminals, and a gaming terminal controller (Mayeroff discloses in Col. 3 Lines 10-15 that the machine has internal electronics to control it, also Walker paragraph 68, each gaming device has a processor that allows it to communicate with other machines).

Re Claim 22,

Mayeroff in view of Walker further teaches a gaming system, wherein each of the plurality of gaming terminals are identical machines (Walker Paragraph 42, the gaming

machines can be any gaming machine, including slots, poker, etc. Because each gaming machine can be any of the disclosed gaming machines, the system is inherently capable of supporting all of the machines being the same machine).

Re Claim 24,

Mayeroff in view of Walker further teaches the gaming system of claim 19, wherein the first payout is a bonus game payout (Mayeroff shows possible bonus game payouts in Table 3).

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN J. HYLINSKI whose telephone number is (571)270-1995. The examiner can normally be reached on M-Thurs. 7:00a-5:30p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on 571-272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/
Primary Examiner, Art Unit 3714

/Steven J Hylinski/
Examiner, Art Unit 3714